

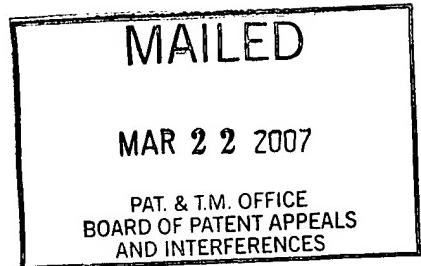
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN D. DREHER

Appeal No. 2007-0627
Application No. 09/482,773
Technology Center 1600



ON BRIEF

Before ADAMS, MILLS, and GREEN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

VACATUR and REMAND TO THE EXAMINER

On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate¹ the pending rejections and remand the application to the examiner to consider the following issues and to take appropriate action.

¹ Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists.

Appellant appeals under 35 U.S.C. § 134 the examiner's final rejection of claims 1-11.² Claim 1 is representative of the claims on appeal, and reads as follows:

1. A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

Claims 1-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Kimura and Hineno. In addition, claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious over the previous combination as further combined with Hurst.

For the following reasons, we vacate the rejections of record and remand the application to the examiner for further consideration.

DISCUSSION

Claims 1-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Kimura and Hineno.

Kimura is cited for teaching a foundation comprising 9.0% by weight of blue interference pigment and iron oxides, and 11% by weight of titanium dioxide (Answer 4). Thus, Kimura teaches the composition of claim 1, as well as a method of applying it to the skin. The examiner contends that "the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim." *Id.*

² Claims 1-34 are pending in the application, and all claims have been rejected. Appellant is appealing only the rejection of claims 1-11.

The examiner notes that Kimura “fails to explicitly teach using the composition to visibly reduce wrinkles or lines of the skin.” *Id.* Hineno is cited for its teaching of a “composite powder comprising interference or reflective pigment useful in covering wrinkle[s, sic] and improving skin color.” *Id.* The examiner cites Example 6, which teaches a foundation comprising serecite, iron oxides, and a composite powder. *Id.* The examiner thus asserts that Hineno would motivate one of ordinary skill in the art to use the composition taught by Kimura to enhance wrinkle-coverage and improve skin color tone.

Appellant argues that if the Examiner is asserting that one practicing the method of Kimura is inherently practicing the method of the claimed method, “that is, that the method in the patent will function in the claimed beneficial manner when topically applied to the skin, then the Examiner is confusing an obviousness analysis with anticipation based on inherency” (Br. 7).³

We agree. The Examiner’s statement that “the prior art composition, when used by the users with aged skin, obviously renders the wrinkle minimizing effect which applicants claim,” makes it unclear if the statutory basis of the rejection is 35 U.S.C. § 102 or 35 U.S.C. § 103. Because we are of the opinion that the teachings of Kimura are pertinent to the patentability of the claims, we vacate the pending rejections and remand the application back to the examiner to further reconsider the patentability of the claims in view of the following statements.

³ All references to the Brief are to the Supplemental Brief, dated February 21, 2006.

“A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. ‘Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates.’ Moreover, ‘[i]nherency is not necessarily coterminous with knowledge of those ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.’” *Nicholas V. Perricone, M.D. v. Medics Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citations omitted).

Claim 1 is drawn to a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment. The statement in the preamble of “a method of reducing the appearance of lines and wrinkles associated with aging of the skin” is a statement of intended use and not a patentable limitation.

See Pitney Bowes, Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999) (“If . . . the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no

significance to claim construction because it cannot be said to constitute or explain a claim limitation.”).

Thus, what is required by the claim is applying to skin exhibiting lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment. Giving the claim its broadest reasonable interpretation, *see In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (during ex parte prosecution, claims are to be given their broadest reasonable interpretation consistent with the description of the invention in the specification); the phrase “skin exhibiting lines and wrinkles” would be any noticeable level of lines and wrinkles.

Both the examiner and appellant appear to agree that Kimura teaches all of the limitations of claim 1 except for applying the makeup composition containing the interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment to skin exhibiting lines and wrinkles.

As taught by *Wrinkles and Wrinkle Treatments*,⁴ “certain inevitable problems happen” to the aging skin, one of which is wrinkles. Factors that can cause skin to wrinkle are sunlight and UV radiation from the sun. *Id.* *Wrinkles and Wrinkle Treatments* teaches that as early as 20-25 years of age, vertical wrinkles on the forehead and between the eyebrows may become visible, and that from 25-35 wrinkles begin to deepen. Between 35-50, deeper wrinkles occur, and laughter lines and crow’s feet also deepen. Thus, this reference teaches that the appearance of wrinkles and lines is an

⁴ www.Skin-Care-reviews.com, printed February 15, 2007.

inevitable event, and lines and wrinkles may be visible as early as 20-25 years of age, but are clearly visible by 35 years of age. Thus, anytime the makeup composition of Kimura is applied to the skin of a person 25 to 35 years of age and older, it is inherently applied to skin exhibiting lines and wrinkles. And even though the result, reducing the appearance of those lines of wrinkles, is not a patentable limitation, it would inherently be achieved by the makeup composition and its method of use taught by Kimura.

Appellant argues, citing *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 66 (1923), that “accidental occurrences of the claimed subject matter, not intended and not appreciated, do not constitute anticipation” (Br. 7). Appellant asserts that “[o]ne simply cannot ignore that the [Kimura] reference does not teach applying the composition to skin exhibiting lines and wrinkles for the specific purpose of reducing the appearance of lines and wrinkles associated with aging of the skin.” *Id.*

Appellant’s arguments are not found to be convincing. As set forth in *Perricone*, the ordinary artisan need not recognize the inherent characteristics or functioning of the prior art. As set forth above, wrinkles and lines are inevitable, inherent results of aging of the skin. Thus, application of the makeup composition to the skin of a person 25 to 35 years of age and older is inherent application to skin exhibiting lines and wrinkles. *Se, e.g., Perricone*, 432 F.3d at 1379-80, 77 USPQ2d at 1328-29 (finding claims inherently anticipated when all that was required was applying a known composition to skin, wherein the skin suffered from damage that was a natural result of the aging process of skin).

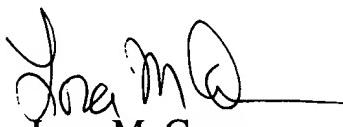
FUTURE PROCEEDINGS

The case is being returned to the jurisdiction of the examiner for further action not inconsistent with this opinion.

If prosecution is resumed, we state that we are not authorizing a Supplemental Examiner's Answer.

VACATED and REMANDED


Donald E. Adams)
Administrative Patent Judge)
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Demetra J. Mills) BOARD OF PATENT
Administrative Patent Judge)
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Lora M. Green) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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